REMARKS

In the non-final Office Action, the Examiner rejects claims 1-16 under 35 U.S.C. § 112, second paragraph, as indefinite; rejects claims 1, 2, 4-6, 9-11, and 14-16 under 35 U.S.C. § 103(a) as unpatentable over L'HEUREUX et al. (U.S. Patent No. 6,697,942) in view of ENGSTROM et al. (U.S. Patent No. 7,212,808); and rejects claims 3, 7, 8, 12, and 13 under 35 U.S.C. § 103(a) as unpatentable over L'HEUREUX et al. Applicants respectfully traverse these rejections.

By way of the present amendment, Applicants amend claims 1-16 to improve form. Applicants have added claims 17-20. No new matter has been added by way of the present amendment. Claims 1-20 are pending in the present application.

Rejection under 35 U.S.C. § 112, second paragraph

Claims 1-16 stand rejected under 35 U.S.C. § 112, second paragraph, as being allegedly indefinite for allegedly failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Applicants respectfully traverse this rejection.

The Examiner alleges (Office Action, p. 2):

As per applicant's arguments that the disclosed prior art message type selection does not constitute the claimed message type, the examiner contends that it is not clear exactly what defines the term 'transmission protocol'. For the purpose of examination the examiner assumes it refers specifically to the known mms, sms, ems protocols.

Without acquiescing to the definition assigned by the Examiner to the term "transmission protocol," Applicants respectfully note that claims 1-16 do not recite the term

"transmission protocol." As such, Applicants respectfully submit that the Examiner's concerns with regard to 35 U.S.C. § 112, second paragraph, do not relate to claims 1-16.

Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 1-16 under 35 U.S.C. § 112, second paragraph.

Phone call regarding rejection of claims 1, 2, 4-6, 9-11, and 14-16

On June 4, 2009, Applicants' representative, Sadiq Ansari, telephoned Examiner Alexander Jamal to clarify the rejection of claims 1, 2, 4-6, 9-11, and 14-16. During the phone call, the Examiner clarified that the abovementioned claims are rejected under 35 U.S.C. § 103(a), and not 35 U.S.C. § 102(e), as indicated on page 3 of the Office Action. Applicants thank the Examiner for taking the time on the phone to clarify the rejection.

Rejection under 35 U.S.C. § 103(a)
based on L'HEUREUX et al. and ENGSTROM et al.

Claims 1, 2, 4-6, 9-11, and 14-16 stand rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over L'HEUREUX et al. in view of ENGSTROM et al. Applicants respectfully traverse this rejection.

Independent claim 1, as amended, is directed to a method of preparing a message in an electronic communication device, the method comprising providing, via a display of the electronic communication device, a set of message types that can be selected by a user in an editor common for all message types of a plurality of message types; detecting, via a control unit of the electronic communication device, a user selection of a particular message type of the plurality of message types; receiving the message in the editor; and changing, via the control unit, a transmission format for the message in dependence of the user selection, where the message is received in advance of the changing the transmission

format. L'HEUREUX et al. and ENGSTROM et al., whether taken alone or in any reasonable combination, do not disclose or suggest this combination of features.

For example, L'HEUREUX et al. and ENGSTROM et al., whether taken alone or in any reasonable combination, do not disclose or suggest providing, via a display of the electronic communication device, a set of message types that can be selected by a user in an editor common for all message types of a plurality of message types. The Examiner relies on col. 3, lines 1-30 of L'HEUREUX et al. as allegedly disclosing providing, via a display of the electronic communication device, a set of message types that can be selected by a user in an editor common for all message types (Office Action, p. 3). Applicants respectfully submit that neither this section nor any other section of L'HEUREUX et al. discloses or suggests the above feature of claim 1, as amended.

At col. 3, lines 1-31, L'HEUREUX et al. discloses:

SUMMARY OF THE INVENTION

The present invention describes a data formatting method for embedding diverse data types in an electronic mail message by forming a network compliant e-mail message header, generating one or more command blocks representing diverse data types, and combining the data types with the message header such that the e-mail message conforms to network standards. In operation, data are edited on and sent from a first system, for example, a subscriber service center, by means of a set of custom message commands. The editing system at the sender's location employs a Graphical User Interface (GUI) enabling non-sophisticated users to create complex mixed data type messages. The mixed data type message may contain commands to reset the configuration of a remote device, for example to change a password or update a device setting. Additionally, other segments, or blocks of the message may contain a graphic image and/or a plain text message. The exact nature of the data depends upon predefined data types.

At the sender's location the mixed data type message is passed from the graphical user interface to a command formatter which translates the GUI output into a custom command format suitable for the receiving apparatus

to interpret. A standard e-mail header is then formed and the two parts of the message are combined into e-mail format for transmission. Once in the proper format, the e-mail message may be transferred over standard e-mail networks using standard e-mail protocols. For example, an e-mail message may be sent over the Internet to a SMTP server using SMTP/MIME protocols. From the SMTP server the message is transferred to the recipient's POP server where it is stored until the recipient downloads it during an e-mail session.

This section of L'HEUREUX et al. discloses embedding diverse data types into an electronic mail message. In other words, there is a single message type (*i.e.*, e-mail) into which different data types (*e.g.*, plain text, graphic image) can be incorporated. This section of L'HEUREUX et al. does not disclose a common editor for all message types – this section of L'HEUREUX et al. at best discloses an editor for a single message type.

Moreover, this section of L'HEUREUX et al. does not disclose a set of message types that can be selected by a user, as L'HEUREUX et al. discloses only a single message type. As such, Applicants respectfully submit that L'HEUREUX et al. does not disclose or suggest providing, via a display of the electronic communication device, a set of message types that can be selected by a user in an editor common for all message types of a plurality of message types, as recited in claim 1, as amended.

In fact, Applicants respectfully submit that L'HEUREUX et al. teaches away from a set of message types that can be selected by a user in an editor common for all message types. L'HEUREUX et al. is directed to "embedding diverse types in an electronic mail message" (L'HEUREUX et al., Abstract) (emphasis added). The above section of L'HEUREUX et al. elaborates on a method by which different data types are incorporated into a "standard" e-mail. For instance, a "standard e-mail header" is

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formed, and the "e-mail message [is] transferred over standard e-mail networks using standard e-mail protocols" (L'HEUREUX et al., col. 3, lines 26-29) (emphasis added).

Applicants respectfully submit that to construe L'HEUREUX et al. as disclosing a set of message types, or an editor common for all message types would completely obviate the entirety of L'HEUREUX et al.'s teachings, which are directed to modifying and sending a standard e-mail. As such, Applicants respectfully submit that L'HEUREUX et al. teaches away from providing, via a display of the electronic communication device, a set of message types that can be selected by a user in an editor common for all message types of a plurality of message types, as recited in claim 1, as amended.

Applicants respectfully submit that the disclosure of ENGSTROM et al. does not remedy the deficiencies in the disclosure of L'HEUREUX et al. set forth above.

Additionally, Applicants respectfully submit that L'HEUREUX et al. and ENGSTROM et al., whether taken alone or in any reasonable combination, do not disclose or suggest detecting, via a control unit of the electronic communication device, a user selection of a particular message type of the plurality of message types. The Examiner does not specifically address this feature, but appears to allege that L'HEUREUX et al. discloses that "[t]he user selects the message type" (Office Action, p. 3). Applicants respectfully disagree with the Examiner's allegation.

Applicants respectfully submit that there is no support in the disclosure of L'HEUREUX et al. for the Examiner's allegation that L'HEUREUX et al. discloses that a user can select a message type. As mentioned above, L'HEUREUX et al. is directed only towards e-mail – a user cannot select another message type. As such, Applicants

respectfully submit that L'HEUREUX et al. cannot disclose or suggest providing, via a display of the electronic communication device, a set of message types that can be selected by a user in an editor common for all message types of a plurality of message types, as recited in claim 1, as amended.

Applicants respectfully submit that the disclosure of ENGSTROM et al. does not remedy the deficiencies in the disclosure of L'HEUREUX et al. set forth above.

Further with respect to claim 1, the Examiner alleges (Office Action, p. 3):

> [t]he terminal inherently comprises input means and display means for the purpose of letting the user 'select' any known type of data to be transferred (selecting a message type, and detection of a user selection)

Applicants respectfully disagree with the Examiner's allegations. Terminal 110 in L'HEUREUX et al. corresponds to an editing terminal, such as a desktop computer (L'HEUREUX et al., col. 4, line 66-col. 5, line 2). L'HEUREUX et al. discloses that terminal 110 is used to compose e-mail messages that include the diverse data (L'HEUREUX et al., col. 4, line 66-col. 5, line 2). Clearly, L'HEUREUX et al. does not disclose or suggest (inherently or otherwise) input means and display means, as the Examiner alleges, for the purpose of letting a user select a message type. The Examiner provides no evidence to support the inherency assertion. Accordingly, the Applicants respectfully submit that Examiner has not met the burden required to establish a proper case of inherency.

Applicants respectfully submit that the disclosure of ENGSTROM et al. does not remedy the deficiencies in the disclosure of L'HEUREUX et al. set forth above.

Furthermore, with respect to claim 1, the Examiner alleges (Office Action, p. 3):

> L'Heurux discloses a messaging system (email) for a portable terminal
> that provides a common interface for different message types (abstract).

Applicants respectfully disagree with the Examiner's allegation that L'HEUREUX et al. discloses a common interface for different message types. As mentioned above, L'HEUREUX et al. is directed to only a single message type (*i.e.*, e-mail), and does not disclose a common for different message types.

Applicants respectfully submit that the disclosure of ENGSTROM et al. does not remedy the deficiencies in the disclosure of L'HEUREUX et al. set forth above.

For at least the foregoing reasons, Applicants submit that claim 1 is patentable over L'HEUREUX and ENGSTROM et al. Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claim 1 under 35 U.S.C. § 103(a) based on L'HEUREUX et al. and ENGSTROM et al.

Claims 2, 4, and 5 depend from claim 1. Therefore, Applicants submit that these claims are patentable over L'HEUREUX et al. and ENGSTROM et al. for at least the reasons given above with respect to claim 1. Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 2, 4, and 5 under 35 U.S.C. § 103(a) based on L'HEUREUX et al. and ENGSTROM et al. Moreover, these claims are patentable for additional reasons of their own.

For example, claim 5 recites that the saving a message is performed in a general format. With respect to this feature, the Examiner alleges (Office Action, p. 4):

> all data must be saved (in a 'general format') at every processing stage in
> the terminal in order for the data to be processed

The Examiner appears to allege that this feature is inherent in the disclosure of L'HEUREUX et al. Applicants respectfully disagree.

Applicants submit that the Examiner has not provided the showing required to establish that the above feature of claim 5 is an inherent part of L'HEUREUX et al.'s terminal. M.P.E.P. § 2112 requires the Examiner, when relying on the theory of inherency, to provide "a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic <u>necessarily</u> flows from the teachings of the applied prior art." <u>Ex parte Levy</u>, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).

Here, the Examiner has not provided the necessary showing articulated in M.P.E.P. § 2112 to support the inherency assertion. In fact, the Examiner merely provides a conclusory statement that L'HEUREUX et al.'s terminal must store data in a general format. Applicants' claim 5, however, is directed to saving the message in a general format prior to receiving a selection of a message type. L'HEUREUX et al.'s terminal formats and transmits electronic mail messages only. L'HEUREUX et al. in no way discloses or suggests (inherently or otherwise) that the terminal saves the message in anything other than an electronic mail format, let alone <u>a general format</u>, prior to receiving a selection of a message type, as would be required of L'HEUREUX et al. based on the Examiner's interpretation of claim 5.

If this rejection is maintained, Applicants respectfully request that the Examiner provide evidence to support the allegation that L'HEUREUX et al.'s terminal inherently saves the message in a general format prior to deciding a final message type.

Furthermore, Applicants note that Applicants' previous Amendment included remarks traversing this same allegation. Applicants believe that the Examiner has not considered and substantively responded to Applicants' remarks with respect to this

allegation, as is required of the Examiner. *See* M.P.E.P., § 707.07(f). Therefore, Applicants respectfully request that the Examiner fully consider and respond to the above remarks regarding claim 5.

Applicants respectfully submit that the disclosure of ENGSTROM et al. does not remedy the deficiencies in the disclosure of L'HEUREUX et al. set forth above.

For at least these additional reasons, Applicants submit that claim 5 is patentable over L'HEUREUX et al. and ENGSTROM et al. Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claim 5 under 35 U.S.C. § 103(a) based on L'HEUREUX et al.

Independent claim 6 recites features similar to (yet possibly different in scope than) features described above with respect to claim 1. Therefore, Applicants respectfully submits that claim 6 is patentable over L'HEUREUX et al. and ENGSTROM et al., whether taken alone or in any reasonable combination, for at least the reasons given above with respect to claim 1. Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claim 6 under 35 U.S.C. § 103(a) based on L'HEUREUX et al. and ENGSTROM et al.

Claims 9-11 and 14-16 depend from claim 6. Therefore, Applicants submit that these claims are patentable over L'HEUREUX et al. and ENGSTROM et al. for at least the reasons given above with respect to claim 6. Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 9-11 and 14 under 35 U.S.C. § 103(a) based on L'HEUREUX et al and ENGSTROM et al. Moreover, these claims are patentable for additional reasons of their own.

For example, <u>claim 9</u> recites features similar to (yet possibly of different scope than) features described above with respect to claim 5. Therefore, Applicants submit that claim 9 is patentable over L'HEUREUX et al. and ENGSTROM et al. for at least reasons similar to reasons given above with respect to claim 5. Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claim 9 under 35 U.S.C. § 103(a) based on L'HEUREUX et al. and ENGSTROM et al.

Rejection under 35 U.S.C. § 103(a) based on L'HEUREUX et al.

Claims 3, 7, 8, 12, and 13 stand rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over L'HEUREUX et al. Applicants respectfully traverse this rejection.

At the outset, Applicants respectfully submit that the rejection of claims 3, 7, 8, 12, and 13 as being allegedly unpatentable over L'HEUREUX et al. is improper. The Examiner has rejected claims 1 and 6, from which these claims depend, as being allegedly unpatentable over L'HEUREUX et al. in view of ENGSTROM et al. However, the Examiner has not cited ENGSTROM et al. as a reference for the rejection of claims 3, 7, 8, 12, and 13. As such, Applicants respectfully submit that this rejection is improper.

Notwithstanding the improper rejection, <u>claim 3</u> depends from claim 1. Therefore, this claim is patentable over L'HEUREUX et al. and ENGSTROM et al. for at least the reasons given above with respect to claim 1. Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claim 3 under 35 U.S.C. § 103(a) based on L'HEUREUX et al. (alone or in any reasonable combination with ENGSTROM et al.).

<u>Claims 7, 8, 12, and 13</u> depend from claim 6. Therefore, these claims are patentable over L'HEUREUX et al. and ENGSTROM et al. for at least the reasons given

above with respect to claim 6. Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 7, 8, 12, and 13 under 35 U.S.C. § 103(a) based on L'HEUREUX et al. (alone or in any reasonable combination with ENGSTROM et al.).

New claims

New claim 17 depends from claim 1. Therefore, Applicants submit that claim 17 is allowable over the art of record for at least the reasons given above with reference to claim 1.

New independent claim 18 is directed to a method comprising, at a display of a communication device, displaying a message editor without requiring selection of a message type; via a first input unit of the communication device, receiving a message at the message editor; after receiving the message, displaying, at the display of the communication device, a plurality of selectable candidate message types for the message; receiving, via a second input unit of the communication device, a selection of a particular message type; and assigning the selected particular message type to the received message. Applicants submit that the art of record does not disclose or suggest this combination of features.

New claims 19 and 20 depend from claim 18. Therefore, Applicants submit that claims 19 and 20 are allowable over the art of record for at least the reasons given above with reference to claim 18.

Conclusion

In view of the foregoing amendments and remarks, Applicants respectfully request the Examiner's reconsideration of this application, and the timely allowance of the pending claims.

As Applicants' remarks with respect to the Examiner's rejections are sufficient to overcome these rejections, Applicants' silence as to assertions by the Examiner in the Office Action or certain requirements that may be applicable to such assertions (e.g., whether a reference constitutes prior art, reasons to modify a reference and/or to combine references, assertions as to dependent claims, etc.) is not a concession by Applicants that such assertions are accurate or such requirements have been met, and Applicants reserve the right to analyze and dispute such assertions/requirements in the future.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-1070 and please credit any excess fees to such deposit account.

Respectfully submitted,

HARRITY & HARRITY, LLP

By: /Sadiq A. Ansari, Reg. No. 64,270/
        Sadiq A. Ansari
        Registration No. 64,270

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11350 Random Hills Road
Suite 600
Fairfax, Virginia 22030
(571) 432-0800
Customer Number: 58561